

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

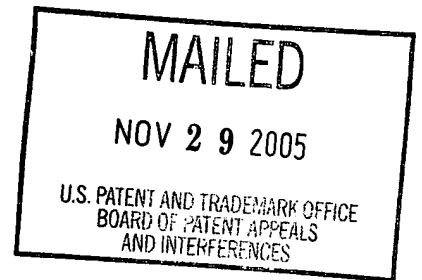
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, DALE BLACKSON, LILEI CHEN,
BOB A. CICHON, MARK S. COVERT, BRADRIK Q. LEPPER,
MARK A. MOALES, MARK D. SMITH, ROBERT J. LEMLEY,
MICHAEL E. CALIFF JR., SHAWN D. JOYCE, PHILLIP S. MOORE and
STEVEN C. SWINGLER

Appeal No. 2005-2538
Application No. 09/077,337

ON BRIEF



Before OWENS, RUGGIERO and BARRY, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 31, 35, 38, 41, 44, 45 and 48-54. Claims 1-30, 32-34, 36, 37, 39, 40, 42, 43, 46 and 47 stand withdrawn from consideration.

THE INVENTION

The appellants claim an automated banking machine that dispenses sheets or notes in response to receipt of a document by a computer. Claim 31 is illustrative:

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31. An automated banking machine comprising:

a computer;

a browser operating in the computer;

a sheet dispenser mechanism in operative connection with the computer, wherein the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the automated banking machine.

THE REFERENCES

Anderson et al. (Anderson) 5,706,442 Jan. 6, 1998
(filed Dec. 20, 1995)

"TP-Monitor Vendors Spin Web Features", 18 *InfoWorld* 37 (1996).

"Trade It Yourself Bank Machines Make a Debut", *Los Angeles Times*, Oct. 6, 1994, Business Section at 1.

THE REJECTION

Claims 31, 35, 38, 41, 44, 45 and 48-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Los Angeles Times in view of InfoWorld or Anderson.

OPINION

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 31, 35, 38, 41, 44 and 51.

Declaration under 37 CFR § 1.131

The appellants argue that the Drummond declaration (filed

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July 10, 2001) shows reduction to practice prior to February 16, 1996 of subject matter that at least would have rendered the appellants' claimed invention obvious to one of ordinary skill in the art (brief, pages 11-14). Thus, the appellants argue, the declaration removes InfoWorld, which has a July 1, 1996 publication date, as prior art. See *id.*

The appellants' claims require dispensing either a sheet or a note. Drummond alleges that, prior to February 16, 1996, he reduced to practice an invention having that feature, but that allegation is not supported by the evidence in the declaration. Also, evidence has not been provided which establishes that the sheet or note dispensing would have been obvious to one of ordinary skill in the art from the relied-upon evidence. Consequently, the declaration is not effective for removing InfoWorld as prior art.

Claims 31, 35, 38, 44 and 51

Claims 31 and 35 require dispensing at least one sheet responsive to receipt of at least one document by a browser, and claim 31 further specifies that the document is an HTML format document. Claim 38 requires dispensing at least one sheet responsive to receipt of at least one HTML document by a computer. Claim 44 requires dispensing at least one note

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responsive to receipt of at least one markup language document by a computer. Claim 51 requires dispensing at least one sheet responsive to receipt of at least one markup language document by a computer.

Los Angeles times discloses using an automatic teller machine (ATM) to provide both banking and brokerage services.

InfoWorld discloses a Top End transaction processing monitor having Java client code that sits inside ATMs and runs on personal computers for allowing users to deploy point-of-sale applications over the World Wide Web. Instead of establishing a client-to-server connection using Common Gateway Interface, the Java client downloads into the user's Web browser and establishes a direct link to the Top End back-end operation.

Anderson discloses a computer software system for accessing recent financial information from various financial services providers (abstract). The portion of Anderson relied upon by the examiner (office action mailed July 15, 2003, page 4) discloses that the system uses a distributed approach which allows applications running in the system to be accessible through a number of presentation tools or user interfaces including HTML browsers (col. 2, lines 40-47).

The examiner argues that "[t]he browser interface is the interface through which all the ATM banking functions of the NCR ATM machine [in InfoWorld] are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the web browser interface" (office action mailed July 15, 2003, page 4). InfoWorld does not disclose that a browser interface is used in performing those functions, and the examiner's mere speculation to that effect is not sufficient for establishing a prima facie case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962).

The examiner argues that "[i]t would have been obvious, in view of Infoworld [sic] or Anderson et al, to one of ordinary skill in the art at the time that the invention was made, to provide the Citibank ATM of LA Times with a web browser interface so as to enable the ATM user to perform all the typical ATM functions including transactions over the web and dispensing sheets and currency through the output devices" (office action mailed July 15, 2003, page 4). For a prima facie case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter

to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The applied references do not disclose using a browser to perform sheet or note dispensing, let alone all of the typical ATM functions, and the examiner has not established that the applied prior art itself would have fairly suggested, to one of ordinary skill in the art, using a browser in that manner.

The examiner argues that "[t]he Citibank ATM of LA Times thus modified, would enable a user to conveniently perform all the typical ATM banking and brokerage functions at the ATM screen through a web browser interface and make it appear to the user that the ATM machine was local to the computer resource containing the relevant bank or brokerage account" (office action mailed July 15, 2003, pages 4-5). A person quoted in InfoWorld states, regarding the Top End transaction monitor discussed therein, that "[t]he whole idea is to make one or 10,000 machines look as if they are local to your computing resource". The examiner has not established that this statement, alone or in combination with the other relied-upon prior art, would have

fairly suggested, to one of ordinary skill in the art, using a browser in performing all typical ATM banking and brokerage functions at ATMs, particularly dispensing sheets or notes as required by the appellants' claims.

The examiner "takes official notice of the fact that it is notoriously well known in the art of sheet feeders that the documents processed by the controlling web browser interface of a particular sheet feeding machine contain instructions for controlling the output devices of the machine, such as dispense instructions for feeding sheets through the output devices of the machine, such an arrangement providing an effective and reliable control system for the output devices of the machine" (office action mailed July 15, 2003, page 5), and also takes official notice "[t]hat it is well known that these documents are often HTML documents/pages". See *id.* Official notice is limited to "notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Although, as pointed out by the examiner (answer, pages 3-4), the appellants responded to the examiner's official notice argument by stating that the examiner has not supported the official notice with prior art rather than

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by stating that the noticed facts are not well known (brief, page 21), the appellants' challenge to the official notice indicates that the facts officially noticed are not capable of such instant and unquestionable demonstration as to defy dispute. Consequently, the examiner's official notice is improper.

The examiner argues that ATMs inherently dispense statements (answer, page 3). The examiner must show that the prior art discloses or would have fairly suggested, to one of ordinary skill in the art, dispensing a sheet or a note responsive to receipt of a markup language document or receipt of a document by a browser as required by the appellants' claims, and the examiner has not done so.

The examiner argues that browser pages such as Internet Explorer possess instructions to print a page (answer, page 3). Even if the examiner is correct, the examiner has not explained how that capability, in combination with the applied prior art, would have led one of ordinary skill in the art to the appellants' claimed invention.

For the above reasons we reverse the rejection of independent claims 31, 35, 38, 44 and 51, and their dependent claims 45, 48-50 and 52-54.

Claim 41

Claim 41 requires a computer operative responsive to indicia read with a card reader to receive at least one document and to control a note dispenser in dispensing at least one note from an ATM responsive to the at least one document.

The examiner does not address claim 41, but addresses claim 45 which depends from claim 44 and requires a computer adapted to operate responsive to indicia read by a card reader to cause the computer to receive at least one markup language document (office action mailed July 15, 2003, page 6). The examiner argues that a typical ATM requires a user to insert an ATM card into the ATM's card reader to access the user's bank account, and that all ATMs have a currency note dispenser operative to dispense at least one currency note during the operation of the ATM. See *id.* The examiner argues that the Los Angeles Times Citibank ATM, as modified by the examiner, would have a browser that "would open web pages related to the user, the web pages having previously determined addresses and performing different transactional and informational functions as required by the user." See *id.* The examiner, however, has not established that the relied-upon prior art would have fairly suggested, to one of ordinary skill in the art, a computer that

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is operative responsive to indicia read with a card reader to receive some type of document and to control a note dispenser in dispensing a note responsive to the document.

Accordingly, we reverse the rejection of claim 41.

DECISION

The rejection of claims 31, 35, 38, 41, 44, 45 and 48-54 under 35 U.S.C. § 103 over Los Angeles Times in view of InfoWorld or Anderson is reversed.

REVERSED

Terry J. Owens
TERRY J. OWENS)
Administrative Patent Judge)

Joseph F. Ruggiero
JOSEPH F. RUGGIERO)
Administrative Patent Judge)

Lance Leonard Barba
LANCE LEONARD BARBA)
Administrative Patent Judge)

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